REMARKS/ARGUMENTS

Claims 1-19 are pending in the present application. In the Office Action mailed May 18, 2005, the Examiner rejected claims 1-3, 8-10, and 15-17 under 35 U.S.C. § 102. The Examiner also rejected claims 4-7, 11-14, 18, and 19 under 35 U.S.C. § 103.

Reconsideration is respectfully requested in view of the above amendments to the claims and the following remarks.

I.   Claims 1-3, 8-10, and 15-17 Rejected Under 35 U.S.C. § 102(b)

The Examiner rejected claims 1-3, 8-10, and 15-17 under 35 U.S.C. § 102(b) as being anticipated by "Beyond the Web: manipulating the real world" to Goldberg *et al.* (hereinafter "Goldberg"). This rejection is respectfully traversed.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131 (citing Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). "The identical invention must be shown in as complete detail as is contained in the ... claim." Id. (citing Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). In addition, "the reference must be enabling and describe the applicant's claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention." In re Paulsen, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

Applicants respectfully submit that independent claims 1, 8, and 15 are patentably distinct from Goldberg. Claims 1, 8, and 15, as amended, recite that "the system is designed such that when a request is sent from the client application to the server computer, the server computer will determine whether the gateway or third party software is necessary to service the request." Support for this limitation is found throughout Applicant's specification including, for example, p. 14, lines 19-21, p. 10, lines 18-28, p. 13, lines 24-27, and Figure 16. This limitation is not disclosed by Goldberg.

Goldberg teaches a system that allows "WWW clients from around the world" to control "a robot arm." Goldberg, p. 212. In order to allow such control of the robot arm, Goldberg's "system is comprised of three communicating servers." *Id.* Specifically, Goldberg teaches as follows:

> [w]hen a client request comes in server *A* communicates with server *B*. If that client is an operator [*i.e.*, has logged in and passed the operator test], server *A* must then communicate with a third server, call it *C*, at controls the robot.... Server *A* decodes the ISMPA *X* and *Y* mouse coordinates, and sends them to server *C*.... On server *C*, a customer program decodes these coordinates into a robot command and verifies that the command is legal....If it is, this command is then converted into a robot command format which is sent to the robot over a serial line. Once the robot move is completed server *C* uses the CCD camera to capture ... [an] image of the workspace.....Server *C* then compresses this image... and returns it to sever *A*... and returns it to the operator client.

Id. at 212-213.

The Examiner asserts that Goldberg's "Server C" comprises the claimed gateway computer and that Goldberg's "Server A" comprises the claimed "server computer." Likewise, the Examiner asserts that Goldberg's' camera and the robot comprise the claimed embedded devices. *See* Office Action, p. 2. To the extent that this interpretation of Goldberg is accurate, Goldberg still does not disclose all of the limitations found in independent claims 1, 8 and 15. Specifically, there is no disclosure in Goldberg that "Server A"—which the Examiner believes is the claimed "server"—will, upon receiving a request from the client application, "determine whether the gateway or third party software is necessary to service the request." Moreover, given that the Goldberg's system is designed as a way that web clients may control a robot, Applicant submits that there would be no reason for Goldberg's "Server A" to make any type of determination whether or not a gateway or third party software would be necessary to service the client's request. Rather, the only function of Goldberg's "Server A" is to transmit the commands so that the robotic arm may be controlled.

Accordingly, because Goldberg fails to disclose the limitation that the "server" will "determine whether the gateway or third party software is necessary to service the request," this

reference does not anticipate independent claims 1, 8, and 15 under 35 U.S.C. § 102(b). Withdrawal

of this rejection is respectfully requested.

Claims 2-3 depend either directly or indirectly from claim 1. Claims 9-10 depend either

directly or indirectly from claim 8. Claim 16-17 depend either directly or indirectly from claim 15.

Accordingly, Applicants respectfully request that the rejection of claims 2-3, 8-9, and 16-17 be

withdrawn for at least the same reasons as those presented above in connection with the independent

claims.

II.   Rejection of Claims 4, 5, 11, and 12 Under 35 U.S.C. § 103(a)

The Examiner rejected claims 4, 5, 11, and 12 under 35 U.S.C. § 103(a) based on Goldberg in

view of International Application No. WO 00/76155 to Marcus *et al.* (hereinafter "Marcus"). This

rejection is respectfully traversed.

The M.P.E.P. states that

> To establish a *prima facie* case of obviousness, three basic criteria must
> be met. First, there must be some suggestion or motivation, either in the
> references themselves or in the knowledge generally available to one of
> ordinary skill in the art, to modify the reference or to combine reference
> teachings. Second, there must be a reasonable expectation of success. Finally,
> the prior art reference (or references when combined) must teach or suggest
> all the claim limitations. The teaching or suggestion to make the claimed
> combination and the reasonable expectation of success must both be found in
> the prior art, and not based on applicant's disclosure.

> The initial burden is on the examiner to provide some suggestion of the
> desirability of doing what the inventor has done. To support the conclusion
> that the claimed invention is directed to obvious subject matter, either the
> references must expressly or impliedly suggest the claimed invention or the
> examiner must present a convincing line of reasoning as to why the artisan
> would have found the claimed invention to have been obvious in light of the
> teachings of the references.

M.P.E.P. § 2142.

Applicants respectfully submit that the claims at issue are patentably distinct from the cited

references. The cited references do not teach or suggest all of the limitations in these claims.

Specifically, as noted above, the present claims, as amended, require that "the system is designed such that when a request is sent from the client application to the server computer, the server computer will determine whether the gateway or third party software is necessary to service the request." As explained in greater detail above, this limitation is not taught or suggested by Goldberg. Likewise, Applicants can find no teaching or suggestion in Marcus that relates to this limitation. Accordingly, because the combination of Goldberg and Marcus does not teach or suggest all of the limitations found in claims 4, 5, 11, and 12, this combination of references does not render these claims *prima facie* obvious under 35 U.S.C. § 103(a). Withdrawal of this rejection is respectfully requested.

III. Rejection of Claims 6, 13, and 18 Under 35 U.S.C. § 103(a)

The Examiner rejected claims 6, 13, and 18 under 35 U.S.C. § 103(a) based on Goldberg in view of International Application No. WO 98/53581 to Gaw *et al.* (hereinafter "Gaw"). This rejection is respectfully traversed.

As noted above, a claim cannot be rejected under 35 U.S.C. § 103(a) unless all of the claimed limitations are taught or suggested in the prior art. *See* MPEP § 2142. As a result of this paper, the present claims recite the limitation that "the system is designed such that when a request is sent from the client application to the server computer, the server computer will determine whether the gateway or third party software is necessary to service the request." As explained above, this limitation is not taught or suggested by Goldberg. Likewise, Applicants can find no teaching or disclosure in Gaw that relates to this limitation. Accordingly, because the combination of Goldberg and Gaw does not teach or suggest all of the limitations found in claims 6, 13, and 18, this combination of references does not render these claims *prima facie* obvious under 35 U.S.C. § 103(a). Withdrawal of this rejection is respectfully requested.

IV. Rejection of Claims 7 and 19 Under 35 U.S.C. § 103(a)

The Examiner rejected claims 7 and 19 under 35 U.S.C. § 103(a) based on Goldberg in view of Gaw and in further view of the article written by Philon entitled "Build servlet-based enterprise Web applications: Learn to build better, faster servlets with advanced servlet techniques" (hereinafter "Philion"). This rejection is respectfully traversed.

As noted above, a claim cannot be rejected under 35 U.S.C. § 103(a) unless all of the claimed limitations are taught or suggested in the prior art. *See* MPEP § 2142. As a result of this paper, the present claims recite the limitation that "the system is designed such that when a request is sent from the client application to the server computer, the server computer will determine whether the gateway or third party software is necessary to service the request." As explained above, this limitation is not taught or suggested by either Goldberg or Gaw. Likewise, Applicants can find no teaching or suggestion in Philion that relates to this limitation. Accordingly, because the combination of Goldberg, Gaw and Philion does not teach or suggest all of the limitations found in claims 7 and 19, this combination of references does not render these claims *prima facie* obvious under 35 U.S.C. § 103(a). Withdrawal of this rejection is respectfully requested.

V. Rejection of Claim 14 Under 35 U.S.C. § 103(a)

The Examiner rejected claim 14 under 35 U.S.C. § 103(a) based on Goldberg in view of Philion. This rejection is respectfully traversed.

As noted above, a claim cannot be rejected under 35 U.S.C. § 103(a) unless all of the claimed limitations are taught or suggested in the prior art. *See* MPEP § 2142. As a result of this paper, the present claims recite the limitation that "the system is designed such that when a request is sent from the client application to the server computer, the server computer will determine whether the gateway or third party software is necessary to service the request." As explained above, this limitation is not taught or suggested by either Philion or Goldberg. Accordingly, because the combination of Goldberg and Philion does not teach or suggest all of the limitations found in claim 14, this
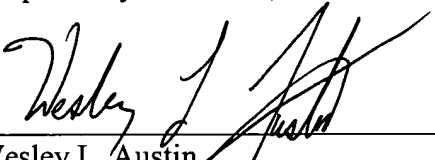
combination of references does not render this claim *prima facie* obvious under 35 U.S.C. § 103(a).

Withdrawal of this rejection is respectfully requested.

VI.   Conclusion

Applicants respectfully assert that all pending claims are patentably distinct from the cited references, and request that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,

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